

Application Serial No. 10/689,910 5
Response dated March 8, 2006
Response to Restriction Requirement dated February 9, 2006

REMARKS

Status of the Case

This application was filed on October 21, 2003, and relates to processes for enriching extracts of natural theanine.

The Examiner's Restriction Requirement

The Examiner has required restriction to one of the following three (3) groups:

Claims 1-10: drawn to a process for isolating theanine from a plant material, comprising:

- a) contacting the plant material with a solvent to obtain an extract comprising theanine;
- b) contacting the theanine extract with an adsorbent to obtain a theanine-containing eluate; and
- c) subjecting the theanine-containing eluate to a filtration step to obtain a theanine-rich extract;

Claims 11-19: drawn to a process for isolating theanine from a plant material comprising:

- a) contacting the plant material with a solvent to obtain an extract comprising theanine;
- b) microfiltering the theanine extract and retaining a theanine-containing retentate;
- c) contacting the theanine-containing retentate with an adsorbent to obtain a theanine-containing eluate; and
- d) subjecting the theanine-containing eluate to a filtration step to obtain a theanine-rich extract; and

Claim 20: drawn to a process for isolating theanine from plant material comprising:

- a) contacting the plant material with a solvent to obtain an extract comprising theanine;
- b) subjecting the theanine extract to column extraction with a polyamide adsorbent to obtain a theanine-containing eluate;
- c) subjecting the theanine-containing eluate to ultrafiltration to obtain a theanine-rich extract; and

Application Serial No. 10/689,910 6
Response dated March 8, 2006
Response to Restriction Requirement dated February 9, 2006

d) further concentrating the theanine-rich extract.

All of the above three groups are classified in Class 424, subclass 729.

Applicants hereby provisionally elect to prosecute the subject matter of Group I, Claims 1-10, drawn to a process for isolating theanine from a plant material. However, Applicants respectfully traverse the restriction requirement and respectfully request reconsideration thereof in view of the following.

In general, MPEP § 803 sets forth the criteria for any restriction requirement, providing that there are two criteria for a proper requirement for restriction between patentably distinct inventions: first, the inventions must be independent or distinct as claimed; and second, there must be a serious burden on the Examiner if restriction is not required.

Presently, the Examiner states that the inventions in the three groups above are unrelated, independent and distinct. More specifically, the Examiner states that "inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Citing MPEP §§ 806.04 and 808.01. The Examiner concludes that "[i]n the instant case, the three different groups are directed to three different inventions. For instance, the three different methods are directed to three different processes for the isolation of theanine from a plant material comprising different process steps and different experimental parameters for the extraction of theanine." See page 3 of Office Action. Moreover, the Examiner states that the inventions are independent from each other and require independent searches. Also, it is stated that a reference which would anticipate one group would not necessarily anticipate another and that the consideration for patentability is different in each case. For these reasons, it is concluded that there is an undue burden on the Examiner to examine all of the groups in one application.

Applicants respectfully disagree with the Examiner's characterization of the present three groups of inventions as independent and distinct. In order to be independent, there must be no disclosed relationship between the two or more subjects disclosed, such that they are unconnected in design, operation or effect. MPEP §802.01. It is respectfully asserted that the Office Action fails to established independence according to the above definition. Simply stating that the three groups require

Application Serial No. 10/689,910 7
Response dated March 8, 2006
Response to Restriction Requirement dated February 9, 2006

independent searches, and that patentability requirements are different, does not amount to a showing of independence in light of the fact that the Office Action indicates that each of the three groups is part of Class 424, subclass 729.

Similarly, in order to be held distinct, it must be shown that two or more subjects as disclosed are related but are capable of separate manufacture, use or sale as claimed and are patentable over each other. MPEP §802.01. In contrast to the conclusions of the Office Action, it is respectfully asserted that distinctness has not been shown. It is improper to conclude that "the three different groups are directed to three different processes." On the contrary, the three different groups are directed to similar processes, the latter two independent claims having an added filtration step occurring at differing points in the process. As such, it is improper to conclude that the three groups represent distinct inventions as defined in the MPEP.

Therefore, for these reasons, it is respectfully asserted that the first criterion for restriction has not been established.

There is also no showing that it would be a serious burden on the Examiner to have to examine all of the independent claims in one application. It is admitted in the Office Action that each of the three groups of inventions belong to Class 424, subclass 729. In view of the fact that the inventions have not been shown to be independent and distinct, it cannot be said that there would be an undue burden on the Examiner to examine the groups together as each group belongs to the same class and subclass and the art useful for examining one group would likely be the same art useful for examining the remaining groups.

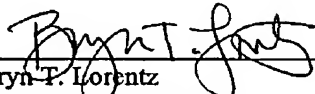
Because the present groups of inventions do not meet the foregoing criteria for establishing independence or distinctness, and undue burden, Applicants respectfully assert a prima facie case for restriction has not been established and therefore, request withdrawal of the rejection based thereon.

Application Serial No. 10/689,910 8
Response dated March 8, 2006
Response to Restriction Requirement dated February 9, 2006

CONCLUSION

Applicants have made an election pursuant to the restriction requirement, with traverse, in accordance with the Examiner's request. Applicants request that the Examiner withdraw the restriction requirement, and allow Claims 1-20 in view of the above remarks.

Respectfully submitted,



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